

REMARKS

Claims 1-3, 5-14, 16, and 17 are pending in the application. Claims 1-3, 5-14, 16, and 17 have been rejected. The Decision of the Appeals board found new grounds for rejection of claim 11. The Decision on Request for Rehearing denominated the affirmance of the rejection of claims 1-3, 5-10, 12-14, 16, and 17 under 35 U.S.C § 102 as involving a new ground for rejection. As such, the rejection of claims 1-3, 5-14, 16, and 17 should no longer be final. Claims 1 and 12 have been amended. No new matter has been added.

Claim Rejections – 35 USC § 112

The Board of Appeals rejected claim 11 under 35 USC § 112 as failing to specify the version or dates of the Lotus Notes® and Lotus Domino Notes®.

Applicant has cancelled claim 11 in this response.

Claim Rejections – 35 USC § 102

Claims 1-3, 5-10, 12-14, 16, and 17 are rejected under 35 U.S.C. 102 as being anticipated by McIlroy. (Application No. 5,583,758). Applicant respectfully traverses the rejection.

Claims 1 and 12

In order for a reference to anticipate a claim, the cited reference must disclose each and every element of the claim. McIlroy fails to disclose each and every element of amended claim. McIlroy fails to disclose the generation of evaluation forms in function of the past history of alternative actions as recited in amended claims 1 and 12..

In the Decision on Request for Rehearing there appears to be some confusion as to what is meant by the phrase “in function of the past history of actions” in claims 1 and 12. The Appeals Board construed the phrase broadly to encompass past history. The Appeals Board suggests that the forms of figures 15 and 16 of McIlroy are generated in function of past history referred to in figure 6. The past history of figure 6 is questions and answers are not actions as set forth in claims 1 and 12. As Applicants argued in the Request for Rehearing, the phrase “in function of the past history of actions” referred to the alternative actions set forth in the claims.

That is, the evaluation forms are generated based on what past history of the hierarchised sequences of alternative actions of said catalogue of recommended actions.

The Appeals Board was not persuaded that the recited “actions” referred to the alternative actions recited. Indeed, on page 4 of the Decision on Request for Rehearing, the Board points out the claims recite “‘past history of actions,’ not ‘past history of alternative actions.’”

Applicants have amended claims 1 and 12 to clarify that the actions references are the alternative actions set forth in claims 1 and 12. McIlroy fails to disclose the generation of evaluation forms in function of the past history of alternative actions.

In light of the foregoing amendments and remarks, Applicants respectfully submit that amended claims 1 and 12 are not anticipated by McIlroy. Applicants therefore request the Examiner withdraw the rejections of claims 1 and 12 under 35 U.S.C. §102, and pass the claim to allowance.

Claims 2-3, 5-10, 13, 14, 16, and 17

Claims 2-3, 5-10, 13, 14, 16, and 17 depend from either claim 1 or claim 12 and as such incorporate each and every element of claim 1 or 12. As discussed above, McIlroy fails to disclose each and every element of amended claims 1 and 12. Therefore, McIlroy fails to disclose each and every element of claims 2-3, 5-10, 13, 14, 16, and 17.

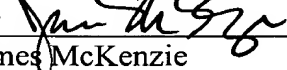
In light of the foregoing amendments and remarks, Applicants respectfully submit that amended claims 2-3, 5-10, 13, 14, 16, and 17 are not anticipated by McIlroy. Applicants therefore request the Examiner withdraw the rejections of claims 2-3, 5-10, 13, 14, 16, and 17 under 35 U.S.C. §102, and pass the claim to allowance.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: January 23, 2006

Respectfully submitted,

By 
James McKenzie
Registration No.: 51,146
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney/Agent For Applicant